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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/237,718	01/26/1999	RICK W. LANDSMAN	UNICAST-1CIP	7166

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EXAMINER	
CARLSON, JEFFREY D	
ART UNIT	**PAPER NUMBER**
3622	

DATE MAILED: 12/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/237,718	LANDSMAN ET AL.	
	Examiner	Art Unit	
	Jeffrey D. Carlson	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *4/13/04, 6/14/04, 9/28/04*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *See Continuation Sheet* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *See Continuation Sheet* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Continuation of Disposition of Claims: Claims pending in the application are 3-10,12-18,20-25,27-33,35,37-44,46-52,54-59,61-67,69,71-78,80-86,88-93,95-102 and 104-108.

Continuation of Disposition of Claims: Claims rejected are 3-10,12-18,20-25,27-33,35,37-44,46-52,54-59,61-67,69,71-78,80-86,88-93,95-102 and 104-108.

DETAILED ACTION

This action is responsive to the paper(s) filed 4/13/04, 6/14/04, 9/28/04.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 3-10, 12-18, 20-25, 27-33, 35, 37-44, 46-52, 54-59, 61-67, 69, 71-78, 80-86, 88-93, 95-102 and 104-108 are rejected under 35 U.S.C. 103(a) as being unpatentable over Judson (US5737619) in view of Capek et al (US6094677) and Merriman et al (US5948061). Judson teaches the desire to display locally cached information (such as ads [col. 2 line 2, col. 7 lines 22-25]) to a user's web browser while the user waits for requested page content to be downloaded. Judson states that text or image content could be displayed during such wait periods. Judson teaches code in the requested web pages that request downloading of various, specified ads. Merriman et al teaches methods for providing webpages that include embedded coding in the pages that when executed by the browser cause ads (information objects) such as images, audio or video to be downloaded. The browser-executed requested webpages cause retrieval and display of the page content from the content server, as well as notify a management (ad) server to select an ad to be delivered to the user. The ad server selects the ad to be downloaded and does so by decoupling the ad

content/selection/location from the webpage content [col 3]. Clearly, the flexibility offered by allowing the server to choose the ad content and the particular ad files to send eliminates the need to hard-code specific advertising content/files in the referring page. In this manner, different users visiting the same pages can experience different (targeted) advertising. It would have been obvious to one of ordinary skill at the time of the invention to have included such uncoupled coding/ad tags with the pages of Judson so that targeted, user-specific ads could be selected for local caching and subsequent interstitial display. Regarding the "network server," the tcp/ip Internet request from the user's browser to the management server inherently is sent to the user's ISP as well as a number of servers located between the ISP and the destination server. Judson describes several processes/tests that determine/control browser function in order to implement the invention. Column 6 lines 13-16 describe that step 74 provides a test to determine whether a link associated with the object/ad is activated. Column 6 lines 18-28 describe a process where the client retrieves and displays the ad object in parallel with the downloaded of the requested content page. Step 84 includes a test/routine to determine whether the display is complete and allows the display of the requested content page. Column 7 lines 25-33 describe programming at the browser level to insert ads randomly, or even selective ads according to the user's history. Column 8 lines 30-43 describe the use of browser-executed Java applets (inherently include scripts and server url) to implement interactive/dynamic ads. Capek et al also describes methods to insert information (inserts can be ads [col. 8 lines 3+]) during delays in retrieving browser requested pages/information. Capek et al describes the use of

browser executed applets to accomplish several features such as detecting a client request for remote information [col 7 lines 18-23], determining the future delay duration [col 10 lines 9-12], and selecting relevant ads based on the users profile [col 5 lines 9-12]. It would have been obvious to one of ordinary skill at the time of the invention to have provided code-based applets with that of Judson in a manner as taught by Capek et al so that the tests and routines of Judson can be accomplished. Capek et al teaches the identification of each ad as well as the queuing of ads and playing the ads in a particular order [col 8 line 59 to col 9 line 5]. It would have been obvious to one of ordinary skill at the time of the invention to have downloaded the ads sequentially in the same order as they are to be played. The managers described by Capek et al can be taken to be "agents". It would have been obvious to one of ordinary skill at the time of the invention to have implemented the programming/managers as persistent within the user's browsing session so that other session-specific functions can be carried out as is well known, such as time of session tracking and customizing the ads for the specific user's session. Column 12 lines 39-42 describe a process of checking the configuration of the user's computer to determine whether a particular type of ad can be played back/displayed. It would have been obvious to one of ordinary skill at the time of the invention to have included a file describing the ad identity (as above) as well as the configuration options needed to successfully play the ad. Regarding claim 12, a new user session would inherently download and invoke the most recently stored applet, however it would have been obvious to one of ordinary skill at the time of the invention

to have checked for more recent versions so as to enable programming changes immediately.

Conclusion

Applicant argues that Merriman et al does not teach decoupling ad content from referring web pages. Applicant appears to concede that Merriman et al teaches a web page that requests advertising, but does so without specifying the particular ad file to be sent; only the ad server is specified and with information sent to the ad server (such as user OS, user cookie, etc). In this manner, the same web page can trigger different ads for different users. This provides a decoupling ad feature which eliminates the need for the webpage to explicitly reference the info object/ad, filename, file address, ad content, etc.

Applicant further argues that Merriman et al provides an example of an inline image (even though selected by the ad server, not the referring webpage) such as a banner ad which is embedded into the referring webpage upon delivery to the browser. Applicant argues that this provides a coupling, distinct from the instant invention. Examiner notes that the rejection combination above suggests decoupling the explicit Judson ad references by specifying only ad server references in order to decouple the webpage coding from the specifics of ad/file selection – this provides the benefit of allowing ads to be selected (and hence customized for the user) not by the page coder, but by an ad server process. Base reference Judson provides the feature of displaying ads interstitially by themselves and they are therefore not embedded and not coupled.

Capek et al provides a motivation to provide functionality by way of applets rather than coding functionality in the web page.

Applicant argues that Merriman et al specifies the information object by way of location (ad server location) and a characteristic of the object (type of object – image). This argument appears to be narrower than the claim language. Applicant argues that an advertiser cannot change the type of object or ad server location without editing the web page itself. Such a feature and one which allows 1:n infinite mapping to objects are not required by the claims. Examiner at this time is not, however, indicating that such features would be allowable.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in

the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 703-308-3402. The examiner can normally be reached on Mon-Fri 8:30-6p, (off on alternate Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc